

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: PATENT APPLICATION of
Inventor(s) Van Hamont, et al.

Appln. No.: 08/698,896 (U.S. Patent No. 5,705,197)
Issued January 1, 1998

Group Art Unit: 1617

Reissue Filed: January 6, 2000

Examiner: T. Criares

Title: HYBRID SOLVENT EVAPORATION-EXTRACTION PROCESS FOR
PRODUCING PLGA MICROSPHERES

Date: March 30, 2001

RESPONSE TO OFFICE ACTION

Hon. Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

In response to the Office Action dated November 30, 2000, please consider the following remarks.

Remarks

Reconsideration and allowance of the subject application are respectfully requested.

In the November 30, 2000 Office Action, claims 11-27 are rejected under 35 U.S.C. §103(a) over applicants' alleged admissions. Specifically, the Examiner has argued that our patent "admits" at column 2, lines 16-34, that "there is a process for preparing PLGA microcapsules involving acetonitrile, mineral oil and heptane" already known in the prior art, and that this renders obvious our present claims.

We agree with the Examiner that a process was known for preparing PLGA microcapsules involving acetonitrile, mineral oil and heptane, but firmly disagree that our process would have been obvious therefrom. Please note column 2, lines 22-34 of our